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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/801,085

03/15/2004

Eifion Phillips

A1695-5P US

9462

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7590

04/18/2006

ASTRA ZENECA PHARMACEUTICALS LP
GLOBAL INTELLECTUAL PROPERTY
1800 CONCORD PIKE
WILMINGTON, DE 19850-5437

EXAMINER

COPPINS, JANET L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/801,085 | Applicant(s) PHILLIPS ET AL. | |
| | Examiner Janet L. Coppins | Art Unit 1626 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 February 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

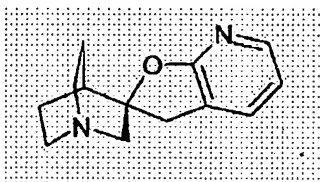
- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-19 pending in the instant application.

Election/Restrictions

1. Applicant's election **without traverse** of Group I, claims 1-8, drawn to products, is acknowledged. The Examiner notes Applicants' further election of the compound of Example 1, spiro[1-azabicyclo[2.2.2]octane-3,2'-(3'H)-furo[2,3-b]pyridine]:



2. Accordingly, Groups II and III, claims 9-19, drawn to methods of use and processes of preparation, currently withdrawn from consideration pursuant to 37 CFR 1.142(b), as directed to non-elected subject matter.

Status of the Claims

3. Claims 1-19 pending in this application. Claims 9-19 are currently withdrawn from consideration by the Examiner, 37 C.F.R. 1.142(b) as being drawn to non-elected inventions. Based on Applicants' elected compound, the scope of the invention of the elected subject matter is as follows:

Compounds according to formula I, wherein A, D, and G are carbon, m is 1, n and p are 0, W is two hydrogens, X is O, Y is N, and R₂-R₄ are as defined, excluding any heteroaryl rings or ring systems.

As a result of the election and the corresponding scope of the invention identified above, the remaining subject matter of claims 1-8 **withdrawn** from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions (compounds and compositions that are

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excluded from the scope of the invention defined above, i.e. wherein **A, D, and G are not all carbon, m is not 1, n or p are not 0, X is S, Y is CH or NO, and R2-R4 contain heteroaryl rings or ring systems).**

The withdrawn compounds contain varying functional groups for the X, Y, A, D, G moieties including heterocyclic or heteroaryl groups which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 (pyrimidinyl), class 546 (pyradinyl), class 548 (oxazolyl), class 549 (thienyl), etc. Therefore the subject matter that has been withdrawn from consideration as being non-elected subject matter, differs materially in structure and composition and has been restricted properly, and a reference that anticipates the elected subject matter would not render obvious the withdrawn subject matter, and the fields of search would not be coextensive.

4. Applicant is reminded that upon the cancellation of subject matter to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-8, in part, rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of U.S. Pat. No. 6,110,914. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and the '914 patent recite a similar genus of pharmaceutical compositions containing spiroazabicyclic heterocyclic compounds with the same core structure (compounds of formula I) and variables that overlap in definition, in fact the only difference is that the '914 patent defines "W" as oxygen, H₂ or F₂, and that "p" can be 0 or 1. The instant application and the '914 patent teach overlapping genres of compounds that are agonists of nicotinic acetylcholine receptors, and are useful for treating psychotic disorders and intellectual impairment disorders.

Conclusion

7. Claims 1-19 are pending in the application, claims 9-19 and claims 1-8, in part, containing non-elected subject matter, are currently withdrawn from consideration, claims 1-8 stand rejected.

Telephone Inquiry

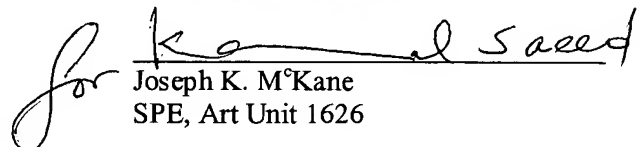
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Coppins whose telephone number is 571.272.0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Coppins
April 14, 2006

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER


for Joseph K. McKane
SPE, Art Unit 1626